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09/237,194

01/26/1999

STEPHEN JAMES BROWN

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HEALTH HERO NETWORK, INC.  
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EXAMINER

MORGAN, ROBERT W

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

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8 *Ex parte* STEPHEN JAMES BROWN  
9

10  
11 Appeal 2009-002452  
12 Application 09/237,194  
13 Technology Center 3600  
14

15  
16 Before HUBERT C. LORIN, ANTON W. FETTING, and BIBHU R. MOHANTY,  
17 *Administrative Patent Judges.*  
18 FETTING, *Administrative Patent Judge.*

19 DECISION ON REQUEST FOR REHEARING<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

1 STATEMENT OF CASE

2 This is a decision on rehearing in Appeal No. 2009-002452. We have  
3 jurisdiction under 35 U.S.C. § 6(b) (2002).

4 Requests for Rehearing are limited to matters misapprehended or overlooked  
5 by the Board in rendering the original decision. 37 C.F.R. § 41.52 (2007).

6 ISSUES ON REHEARING

7 The Appellant contends that our decision to accept Kirk as prior art is  
8 improper, and so the rejections should be reversed (Request 12). The Appellant  
9 raises two issues in the Request for Rehearing. The first issue relates to whether the  
10 panel raised a new ground of rejection that the Appellant was not afforded an  
11 opportunity to respond to (Request 2-3). The second issue relates to whether the  
12 panel did not recognize the adequacy of the evidence of diligence in reduction to  
13 practice (Request 6-11).

14 ANALYSIS

15 We found in our decision that claims 34-138 were unpatentable as being either  
16 anticipated or obvious over the prior art. (Decision 19-20). As the Appellant did  
17 not argue whether the prior art described the rejected claims, the only issue before  
18 us was whether the art as applied in the rejections was prior art. More specifically,  
19 whether Kirk was prior art in view of the evidence offered by the Appellant that  
20 the claimed subject matter was invented prior to Kirk's filing date.

21 The Appellant argues that the panel raised a new ground of rejection that the  
22 Appellant was not afforded an opportunity to respond to (Request 2-3). The  
23 Appellant does not cite to where this occurred in the Decision, but appears to refer  
24 to the Panel's Finding of Fact 40 (Decision 13-14) that the Appellant presented no  
25 evidence that the disclosure in the 07/977,323 application provides a 35

1 U.S.C. § 112 compliant written description of the inventions as recited in the  
2 instant claims.

3 To be clear, the panel did not introduce a new ground of rejection. Application  
4 07/977,323 is not before the Board of Patent Appeals and Interferences, and the  
5 panel made, and makes, no findings as to the patentability of the claims in that  
6 application. Conversely, the disclosure in application 07/977,323 could only form  
7 the basis of a rejection under 35 U.S.C. § 112 over the claims in the instant  
8 application 09/237,194 under the most unusual of circumstances which are not  
9 present here.

10 The Finding of Fact 40 which the Appellant refers to is simply a finding that is  
11 pertinent to the issue of whether the Appellant adequately swore behind the Kirk  
12 reference, as the instant application would need the benefit of the earlier filing date  
13 of application 07/977,323. The panel's finding was just that, a finding of the fact  
14 that the Appellant has not yet introduced any evidence in the record showing  
15 specifically how the disclosure of the earlier application supports the present  
16 claims. The Appellant has not presented such evidence with this Request either.

17 Next, the Appellant apparently requests clarification on the panel's findings  
18 regarding whether conception was shown prior to Kirk's filing date (Request 3).  
19 The Appellant apparently questions whether our Finding of Fact 31 that the  
20 Appellant provided evidence of conception prior to Kirk's filing date (Decision 12)  
21 contradicts the panel's Finding 4 that there are no details of any method or  
22 machine other than the names of some devices, nor are there details showing the  
23 specific components recited in the claims in the evidence provided.

24 To be clear, Finding of Fact 31 simply acknowledges that a declaration is a  
25 form of evidence. This evidence was provided by the Appellant. The panel did

1 not find this was persuasive evidence. Finding of Fact 4 simply finds that, aside  
2 from the Appellant's assertion that conception occurred prior to the filing date of  
3 Kirk, there is no objective evidence supporting that assertion.

4 The Appellant asserts that paragraph 2 of the declaration explains the  
5 associations. (Request 5). However, on its face, the declaration was prepared  
6 subsequent to the filing date of Kirk. Thus, this explanation, while potentially a  
7 helpful support, if such associations already existed in Exhibit B and needed some  
8 minor clarification, is not objective evidence that Exhibit B shows conception of  
9 the invention as claimed. In the absence of anything in Exhibit B that shows those  
10 associations between the contents of Exhibit B and the claimed subject matter  
11 these explanations are unpersuasive.

12 Finally, the Appellant argues the panel did not recognize the adequacy of the  
13 evidence of diligence in reduction to practice (Request 6-11). First we note that  
14 the Request does not contend that the patent attorney responsible for constructive  
15 reduction to practice acted diligently. This is pertinent as the evidence does not  
16 show actual reduction to practice. Second, the Appellant argues that the inventor  
17 was excused from having to diligently reduce the invention to practice because the  
18 inventor was pursuing his full time job as the head of a company. While we agree  
19 that an inventor may be excused for reasonable interruptions, the logical  
20 implication of the Appellant's argument is that an inventor can sit on a conception  
21 until whenever he gets around to reduction to practice by the simple act of working  
22 his day job. This is not the case. Certainly, the head of a company can hire  
23 someone to pursue reduction to practice. In fact, the record suggests that was done  
24 here. Thereafter, the issue is not whether the inventor had the time, but whether  
25 the subordinate was diligently acting on the inventor's behalf. But having hired  
26 such a person, the record shows no details of the development activity performed

by that person as objective evidence of diligence in the reduction to practice.  
Decision 5-12: Findings of Fact 4-29.

### CONCLUSION

Nothing in Appellant's request has convinced us that we have overlooked or misapprehended the evidence as argued by Appellant. Accordingly, we DENY the request.

### DECISION

To summarize, our decision is as follows:

- We have considered the REQUEST FOR REHEARING
- We DENY the request that we reverse the Examiner as to claims 34-138.

### REHEARING DENIED

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